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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/754,927

01/04/2001

Randy L. Prakken

SWIF 1981

3848

7812

7590

12/14/2004

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SUITE 104  
PORTLAND, OR 97229

EXAMINER

SHERR, CRISTINA O

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/754,927

Applicant(s)

PRAKKEN ET AL.

Examiner

Cristina Owen Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on September 20, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In view of the appeal brief filed on September 20, 2004, PROSECUTION IS HEREBY REOPENED.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
  - (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
  - (2) request reinstatement of the appeal.
3. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US 6,775,392).
7. Regarding claim 1 –

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Rhoads discloses a data file distribution and processing system including server software running on a source computer for sending data files to a destination computer via a network link between the source computer and the destination computer, and including processing software running on the destination computer for processing each data file forwarded thereto from said server software to carry out an action, a method for preventing the processing: software running on the destination computer from processing data files forwarded to the destination computer other than from the server software, the method comprising the steps of: including within the server software running on the source computer license stamping means for embedding a license stamp into each data file before the server software forwards the data file to said destination computer via said network link; and adapting said processing software executed by said destination computer so that it processes each received data file to carry out said action only when the received data file contains the embedded license stamp, wherein the license stamp embedded in the data file indicates that the data file was forwarded by licensed server software (e.g. col 5 ln 40 – col 6 ln 65).

8. Regarding claim 2 –

Rhoads discloses the method in accordance with claim 1 wherein said encoded license stamp comprises a code identifying said source computer (e.g. col 17 ln 5-20).

9. Regarding claim 3 –

Rhoads discloses the method in accordance with claim 1 wherein said each data file, including its embedded license stamp, is a print file defining a document in a format suitable for directly causing a printer to print said document (e.g. col 17 ln 5-20).

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10. Regarding claim 4 –

Rhoads discloses the method in accordance with claim 3 wherein said license stamping means embeds said encoded license stamp into the each data file in such a way that said printer ignores the encoded license stamp when printing said document in response to said data file (e.g. col 40 ln 50 – col 41 ln 10).

11. Regarding claim 5 –

Rhoads discloses the method in accordance with claim 3 wherein said action carried out by said processing software comprises displaying on a computer monitor a representation of the document defined by the data file (e.g. col 40 ln 50 – col 41 ln 10).

12. Regarding claim 6 –

Rhoads discloses the method in accordance with claim 3 wherein said action carried out by said processing software comprises causing said printer to print said document (e.g. col 43 ln 30-65).

13. Regarding claim 7 –

Rhoads discloses the method in accordance with claim 1 wherein said data file defines a sound and wherein said action carried out by said processing software comprises initiating said sound (e.g. col 52 ln 65 – col 53 ln 60).

14. Regarding claim 8 –

Rhoads discloses the method in accordance with claim 1 wherein said data file defines a video image and wherein the action carried out by said processing software comprises initiating a display of said video image (e.g. col 52 ln 65 – col 53 ln 60).

15. Regarding claim 9 –

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Rhoads discloses the method in accordance with claim 1 wherein said license stamping means also processes each said data file to determine a value of an attribute of the data file and includes in said embedded license stamp an attribute code indicating said value of said attribute, and wherein the method further comprises the step of adapting the processing software to process each received data file to determine a value of said attribute of each data file received, and to refrain from processing the received data file to carry out said action unless the received data file includes an embedded license stamp containing said attribute code indicating a value of said attribute patching the value of said attribute determined by said processing software (e.g. col 52 ln 65 – col 53 ln60).

16. Regarding claim 10 –

Rhoads discloses the method in accordance with claim 9 wherein the data file processed by said license stamping means consists of a plurality of data bytes, each of which influences the value of said attribute determined by said license stamping means (e.g. col 53 ln 65 – col 64 ln 45).

17. Regarding claim 11 –

Rhoads discloses the method in accordance with claim 1 wherein said license stamping means includes a processing option code within said license stamp embedded within said data file, and wherein the option code influences the nature of the output the processing software produces when processing the data file (e.g. col 53 ln 65 – col 64 ln 45).

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18. Although not every permutation in the instant case is specifically disclosed in Rhoads, it would be obvious to one of ordinary skill in the art that just as the discussed permutations may be made, so may many others.

19. Claims 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US 6,775,392).

20. Regarding claim 12 –

Rhoads discloses a data file distribution and processing system comprising: a source computer; a destination computer and network means for conveying data files from said source computer to said destination computer wherein said source computer executes server software for sending data files to the destination computer via said network means, wherein said destination computer executes processing software for processing each data file forwarded thereto from said server software to carry out an action, wherein said server software includes license stamping means for embedding a license stamp into each data file before the server software forwards the data file to said destination computer via said network means, wherein said processing software processes each received data file to carry out said action only when the received data file contains the embedded license stamp, and wherein the license stamp embedded in the data file indicates that the data file was forwarded by licensed server software (e.g. col 5 ln 40 – col 6 ln 65).

21. Regarding claim 13 –

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Rhoads discloses the data file distribution and processing system in accordance with claim 12 wherein said encoded license stamp comprises a code identifying said source computer (e.g. col 17 ln 5-20).

22. Regarding claim 14 –

Rhoads discloses the data file distribution and processing system in accordance with claim 12 wherein each said data file, including its embedded license stamp, is a print file defining a document in a format suitable for directly causing a printer to print said document (e.g. col 17 ln 5-20).

23. Regarding claim 15 –

Rhoads discloses the data file distribution and processing system in accordance with claim 14 wherein said license stamping means embeds said encoded license stamp into the data file in such a way that said printer ignores the encoded license stamp when printing said document in response to said data file (e.g. col 40 ln 50 – col 41 ln 10).

24. Regarding claim 16 –

Rhoads discloses the data file distribution and processing system method in accordance with claim 14 wherein said action carried out by said processing software comprises displaying on a computer monitor a representation of the document defined by the data file (e.g. col 40 ln 50 – col 41 ln 10).

25. Regarding claim 17 –

Rhoads discloses the data file distribution and processing system in accordance with claim 16 wherein said action carried out by said processing software comprises causing said printer to print said document (e.g. col 43 ln 30-65).



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26. Regarding claim 18 –

Rhoads discloses the data file distribution and processing system in accordance with claim 12 wherein said data file defines a sound and wherein said action carried out by said processing software comprises a initiating said sound (e.g. col 52 ln 65 – col 53 ln60).

27. Regarding claim 19 –

Rhoads discloses the data file distribution and processing system in accordance with claim 12 wherein said data file defines a video image and wherein the action carried out by said processing software comprises indicating a display of said video (e.g. col 52 ln 65 – col 53 ln 60).

28. Regarding claim 20 –

Rhoads discloses the data file distribution and processing system in accordance with claim 12 wherein said license stamping means also processes each said data file to determine a value of an attribute of the data file and includes in said embedded license stamp an attribute code Vindicating said value of said attribute, and wherein the method further comprises the step of adapting the processing software to process each received data file to determine a value of said attribute of each data file received, and to refrain from processing the received data file to carry out said action unless the received data file includes an embedded license stamp containing said attribute code indicating a value of said attribute matching the value of said attribute determined by said processing software (e.g. col 52 ln 65 – col 53 ln60).

29. Regarding claim 21 –

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Rhoads discloses the data file distribution and processing system in accordance with claim 20 wherein the data file processed by said license stamping means consists of a plurality of data bytes, each of which influences the value of said attribute determined by said license stamping means (e.g. col 53 ln 65 – col 64 ln 45).

30. Regarding claim 22-

Rhoads discloses the data file distribution and processing system in accordance with claim 12 wherein said license stamping means includes a processing option code within said license stamp embedded within said data file, and wherein the option code influences the nature of the output the processing software produces when processing the data file (e.g. col 53 ln 65 – col 64 ln 45).

31. Although not every permutation in the instant case is specifically disclosed in Rhoads, it would be obvious to one of ordinary skill in the art that just as the discussed permutations may be made, so may many others.

32. Claims 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US 6,775,392).

33. Regarding claim 23 –

Rhoads discloses a data file distribution and processing system comprising: first means for providing a data file; second means for receiving the data file, for checking the data file to determine whether the data file contains an encoded license, and for thereafter processing the data file only when the data file contains the encoded license; and third means for receiving the data file provided by said first means, for embedding said encoded license in the data file, and for forwarding said data file with the encoded

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license embedded therein to said second means, such that said encoded license indicates said data file as having been forwarded by said third means (e.g. col 5 ln 40 – col 6 ln 65).

34. Regarding claim 24 –

Rhoads discloses the data file distribution and processing system in accordance with claim 23, further comprising a printer, wherein said data file provided by said first means is a print file suitable as input to said printer for instructing said printer to print a document, and wherein said third means processes said data file by displaying an image of said document and by transmitting said data file as input to said printer such that said printer prints said document in response to said print file (e.g. col 17 ln 5-20).

35. Regarding claim 25 –

Rhoads discloses the data file distribution and processing system in accordance with claim 23 wherein said second means embeds said encoded license into the data file in such a way that the printer ignores the encoded license when printing said document (e.g. col 17 ln 5-20).

36. Regarding claim 26 –

Rhoads discloses the data file distribution and processing system in accordance with claim 23 wherein said embedded license includes a code identifying a licensee (e.g. col 53 ln 65 – col 64 ln 45).

37. Although not every permutation in the instant case is specifically disclosed in Rhoads, it would be obvious to one of ordinary skill in the art that just as the discussed permutations may be made, so may many others.

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38. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

39. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

40. Rhoads (US 6,760,463) discloses watermarking methods and media.

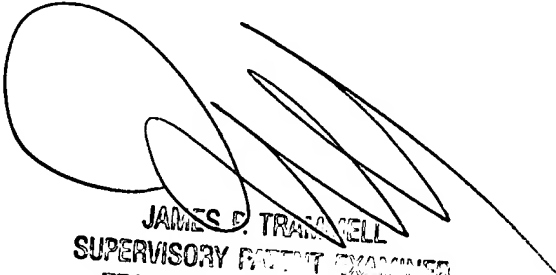
41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

42. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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43. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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